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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,128	05/28/2002	Andre Martin Van Der Ende	8830-38	8119

23973 7590 02/23/2005

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EXAMINER

DANG, HUNG Q

ART UNIT PAPER NUMBER

2635

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 10/088,128

Applicant(s)

VAN DER ENDE ET AL.

Examiner

Hung Q Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. A telephone call was made to Robert Cannuscio on 1/27/2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-10 and 22-25, drawn to a communication system for use in a wellbore through a wireline, classified in class 340, subclass 854.9.

Group II, claim(s) 11-14, drawn to a wire with insulated coating for use in a wellbore, classified in class 174, subclass 30.

Group III, claims(s) 15-21, 26, 27 and 33, drawn to a distance measurement apparatus for measuring distance traveled by a wireline in a wellbore, classified in class 340, subclass 854.1.

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Group IV, claims(s) 28-32, 34 and 35, drawn to an apparatus for indicating the configuration of a downhole tool comprising sensors for sensing a change in the configuration of the downhole tool, classified in class 340, subclass 853.3.

The inventions are distinct, each from the other because of the following reasons:

(a) **Inventions of groups I and II** are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case (a), the combination as claimed does not require the particulars of the subcombination as claimed because the communication system for use in a wellbore through a wireline of group I does not necessarily need the insulated coating wire of group II; the system of group I can alternatively use another type of insulated wire. The insulated wire of group II can also be used with other type of above ground communication systems.

b) **Inventions I and III** are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group I is for transmitting data through a wireline up and down a wellbore. The invention of group III concerns with a distance measurement

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apparatus for measuring distance traveled by a wireline in a wellbore. Clearly, the invention of group I is separately usable for solely transmitting data through a wireline up/down a borehole. Similarly, the distance measurement apparatus for measuring distance traveled by a wireline of group III can be used separately for measuring the distance traveled by a wireline in a borehole. See MPEP § 806.05(d).

c) **Inventions I and IV** are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of group I is for transmitting data through a wireline up and down a wellbore. The invention of group IV concerns with an apparatus for indicating the configuration of a downhole tool comprising sensors for sensing a change in the configuration of the downhole tool. Clearly, these two groups of inventions can be separately used for performing two different functions and purposes. See MPEP § 806.05(d).

d) **Inventions II and III** are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of group II concerns with a wire with insulated coating for use in a wellbore. The invention of group III concerns with a distance measurement apparatus for measuring distance traveled by a wireline in a wellbore. Clearly,

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the insulated wire of group II can be used with other communication networks and the distance measuring apparatus of group III can be used with many other types of wellbore telemetry systems.

e) **Inventions II and IV** are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of group II concerns with a wire with insulated coating for use in a wellbore. The invention of group IV concerns with an apparatus for indicating the configuration of a downhole tool comprising sensors for sensing a change in the configuration of the downhole tool. Clearly, the insulated wire of group II can be used with many other wellbore or above surface communication systems and the invention of group IV can also be separately used for sensing a change in the configuration of the downhole tool.

f) **Inventions III and IV** are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group III concerns with a distance measurement apparatus for measuring distance traveled by a wireline in a wellbore. The invention of group IV concerns with an apparatus for indicating the configuration of a downhole tool comprising sensors for sensing a change in the configuration of the downhole

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tool. Clearly, these two groups of inventions can be separately used for performing two different functions and purposes.

Conclusion

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for group I is not required for groups II, III, IV and vice versa, therefore, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Q Dang whose telephone number is (571) 272-3069. The examiner can normally be reached on 9:30AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HD

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

